



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,073	07/16/2001	Suguru Tsuchiya	P20746	5981

7055 7590 03/24/2006

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT	PAPER NUMBER
----------	--------------

2625

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,073

Applicant(s)

TSUCHIYA, SUGURU

Examiner

Madeleine AV Nguyen

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/13/06, 12/30/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 20, 2005 has been entered.

Response to Arguments

Applicant's arguments filed on November 30, 2005 have been fully considered but they are not persuasive.

A. Applicant remarks that in Yoshida et al, the facsimile machine only has a telephone number, while in the present invention, each of the plurality of the receiving Internet facsimile apparatus has a sub-address and an IP address.

It is noted that the service provider A or B has an electronic mail and fax conversion facsimile machine 1-2 or 1-11, wherein the facsimile machine 1-17 can send fax image data to one of the electronic mail and fax conversion facsimile machine 1-2 or 1-11. For instance, consider a case where the facsimile machine 1-17 send a fax image data to the electronic mail and fax conversion facsimile machine 1-11 in the service provider B as shown in Fig.2. Yoshida et al teaches, "When connecting the line to the service provider of the Internet, the IP address of the opposing service provider (the service provider connected to facsimile machine B of the

Art Unit: 2626

reception side) and a telephone number of the reception side facsimile machine are registered in the register circuit 24 corresponding to the one-touch key.” (col. 26, lines 61-66). Yoshida further teaches, “the control circuit 20 registers the above mentioned information including an IP address and a telephone number of the reception side facsimile machine into the registration circuit 24 responding to the one-touch dial key assigned by key input of the control portion 25. Therefore, in case the fax image data is sent from the facsimile machine 1-17 to the electronic mail and fax conversion facsimile machine 1-11 and not to the facsimile machine 1-13, the one-touch dial key will include an IP address and the identification information of the reception side facsimile machine 1-11 (the facsimile machine 1-11 is also an Internet facsimile machine). Thus, in case the receiving destination is the facsimile machine 1-11, the predetermined identification information has a sub-address (with identification information of the facsimile machine 1-11) and an IP address. In addition, Yoshida teaches that when the service provider A received sub-address signal from the facsimile apparatus 1-17, it analyzed the information set in the received sub-address signal, and judges whether the service provider B corresponding to the IP address is the contracted one or not. If the service provider A sends the image data received from the facsimile machine 1-17 to the facsimile machine 1-11 (Fig. 2, 30-33B; col. 28, lines 2-17). Thus, in the case the receiving destination facsimile machine is the Internet facsimile machine 1-11 and not the facsimile machine 1-13, the information identifying each of the receiving destination facsimile machines are the IP address and the sub-address.

B. Applicant remarks that Yoshida does not disclose that the relay Internet facsimile apparatus having a memory that stores IP addresses of the plurality of receiving Internet

Art Unit: 2626

facsimile apparatuses corresponding to the sub-addresses of the plurality of receiving Internet facsimile apparatuses.

Yoshida teaches that the service provider A judges whether the service provider corresponding to the IP address is the contracted one or not (col. 28, lines 2-17). Yoshida further teaches a plurality of tables stored in the service provider for judging (Figs. 26-28). For instance, the relay facsimile apparatus 1-2 or 1-11 has a sub-address storing buffer 6-1 or 1—1 wherein the received sub-address data is stored, and the stored sub-address data is stored in a relay destination address buffer 1-4 as a relay destination address (col. 20, lines 27-48). Yoshida further teaches a relay destination table which stores registered address information such as telephone number, electronic mail address, country code, and area code of the neighboring country being in charge of the relay. The table is for judging whether the address information is registered or not (col. 21, line 6 - col. 23, line 23). For a facsimile machine communicating with a service provider of the Internet (an Internet relay), the IP address and a telephone number (or an email address) of the receiving Internet facsimile machine is provided (col. 26, lines 59-66; col. 27, line 46 – col. 28, line 17). Thus, the service provider A or B (the relay Internet facsimile apparatus) should have a memory (a table) that stores IP addresses and corresponding sub-addresses of the plurality of receiving Internet facsimile apparatus in order to judge whether the IP address corresponding to a service provider is the contracted one or not.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11-13, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida et al (US Patent No. 6,801,546).

Concerning claim 11, Yoshida teaches a facsimile apparatus (facsimile machine A, Fig.29) transmitting image data to a relay Internet facsimile apparatus (30, Fig.29) via PSTN (34), the relay Internet facsimile apparatus 30 transmitting the image data to a plurality of receiving Internet facsimile apparatuses (32) via the Internet (38), the facsimile apparatus comprising an input device (14) configured to input the image data; a panel (24) configured to input predetermined information identifying the relay Internet facsimile apparatus 30 and sub-address of the receiving Internet facsimile apparatus 32, the relay Internet facsimile apparatus 30 having a memory (8-4, Fig.21 or 10-1, Fig.10) that stores a plurality of addresses of the receiving Internet facsimile apparatuses corresponding to the plurality of the sub-addresses of the receiving Internet facsimile apparatuses (col. 20, line 27 – col. 21, line 65); and a controller (20) that, when the predetermined information and the sub-addresses of the plurality the receiving Internet facsimile apparatus are input by the panel, transmits, to the relay Internet facsimile apparatus via the PSTN, the input image data and the sub-address of the receiving Internet facsimile apparatus, based on the input predetermined information identifying the relay Internet facsimile apparatus, the relay Internet facsimile apparatus converting the transmitted image data into data for Internet

Art Unit: 2626

transmission and relaying the converted data to the receiving Internet facsimile apparatus via the Internet, based on the plurality of the IP addresses of the receiving Internet facsimile apparatuses corresponding to the plurality of the sub-addresses of the receiving Internet facsimile apparatuses stored in the memory of the relay Internet facsimile apparatus (Figs.30-35; Abstract; col. 19, line 30 – col. 21, line 52; col. 25, line 53 – col. 29, line 58; col. 30, lines 31-41; col. 31, lines 3-38; col. 33, lines 16-25; col. 33, line 52 – col. 34, line 2).

Yoshida does not directly teach that the panel input a plurality of sub-addresses of the receiving Internet facsimile apparatus. However, it a matter of well known in the prior art that the user can send facsimile data to a plurality of receiving Internet facsimile apparatuses. For instance, Yoshida teaches, in Fig.5A, a plurality of input destinations in the table (No.1, No.2, No.3), (col. 9, line 60 – col. 10, line 24) wherein each receiving Internet facsimile apparatus has different sub-addresses (Figs.18-20, 23). That means the communication apparatus in Yoshida can receive more than one sub-address. It would have been obvious to one skilled in the art at the time the invention was made to consider the communication system (Fig.29) in Yoshida can input more than one sub-address of the receiving Internet facsimile apparatuses since Yoshida also teaches the case the reception means of the system can receive more than one sub-addresses of the receiving Internet facsimile apparatuses and the facsimile image data can be sent to a plurality of destinations such as 1-13 and 1-14 (Fig.1).

Yoshida does not directly teach that each of the plurality of receiving Internet facsimile apparatuses having a sub-address and an IP address. Since Yoshida teaches that the destination is a conventional facsimile machine, which does not require an IP address. However, from Fig.2, in case the receiving destination is a receiving Internet facsimile apparatus as 1-11 and not 1-13,

an IP address and a sub-address are needed for each receiving Internet facsimile apparatus. For instance, Yoshida et al teaches, "When connecting the line to the service provider of the Internet, the IP address of the opposing service provider (the service provider connected to facsimile machine B of the reception side) and a telephone number of the reception side facsimile machine are registered in the register circuit 24 corresponding to the one-touch key." (col. 26, lines 61-66). Yoshida further teaches, "the control circuit 20 registers the above mentioned information including an IP address and a telephone number of the reception side facsimile machine into the registration circuit 24 responding to the one-touch dial key assigned by key input of the control portion 25. Therefore, in case the fax image data is sent from the facsimile machine 1-17 to the electronic mail and fax conversion facsimile machine 1-11 and not to the facsimile machine 1-13, the one-touch dial key will include an IP address and the identification information of the reception side facsimile machine 1-11 (the facsimile machine 1-11 is also an Internet facsimile machine). Thus, in case the receiving destination is the facsimile machine 1-11, the predetermined identification information has a sub-address (including the address of the facsimile machine 1-11) and an IP address. It would have been obvious to one skilled in the art to consider the case when the receiving destination is the Internet facsimile machine 1-11 so that the receiving Internet facsimile apparatus has a sub-address and an IP address since Yoshida also teaches in Fig.2 that the facsimile image data from G3 facsimile machine 1-17 are transmitted to the Internet facsimile machine 1-11 before transmitting to the G4 facsimile machine.

Yoshida does not directly teach a memory that stores IP addresses of the plurality of receiving Internet facsimile apparatuses. Since the destination taught in Yoshida is the facsimile machine 1-13, which is not an Internet facsimile machine, there is no IP address of the receiving

Internet facsimile apparatus for the memory to store. However, since Yoshida also teaches that the Internet facsimile machine 1-11 receives the facsimile image data from the facsimile machine 1-17 (Fig.2), the memory (8-4, Fig.21) in the relay Internet facsimile machine 1-1-2 should store the IP address of the receiving Internet facsimile apparatus 1-11. It would have been obvious to one skilled in the art at the time the invention was made to consider the case the receiving destination is the Internet facsimile machine 1-11, the relay Internet facsimile apparatus 1-2 has a memory (8-4) which stores IP address of the receiving Internet facsimile machine 1-11 since Yoshida teaches that the relay facsimile machine 1-2 judges whether the IP address of the receiving Internet facsimile machine 1-11 is the contracted one or not by using a table of registered IP addresses (col. 27, line 46 – col. 28, line 27).

Concerning claims 12-13, 15, Yoshida further teaches that the controller transmits the input image data and the sub-address of the receiving Internet facsimile apparatus to the receiving Internet facsimile apparatus based on the predetermined information identifying the relay Internet facsimile apparatus, (col. 27, line 46 – col. 28, line 27; col. 31, lines 2-22), (claim 12); the panel includes a plurality of one-touch buttons, (col. 26, lines 59-61), (claim 13); the predetermined information comprises a telephone number of the relay Internet facsimile apparatus, (col. 26, lines 51-58), (claim 15).

Concerning claim 16, Yoshida discloses a relay Internet facsimile apparatus (30, Fig.29) comprising a memory for storing a plurality of IP addresses of receiving Internet facsimile apparatuses corresponding to a plurality of sub-addresses of the receiving Internet facsimile apparatus; a communicator for receiving from the transmitting facsimile apparatus (facsimile machine A) via PSTN (30), image data and the sub-address of the receiving facsimile apparatus

Art Unit: 2626

in a single facsimile transmission; and a controller that, when the sub-address is received, relays the converted data to the receiving Internet facsimile apparatus via the Internet (38), (Figs.30-35; Abstract; col. 25, line 53 - col. 29, line 58; col. 30, lines 31-41; col. 31, lines 3-38).

Yoshida does not directly teach that the communicator receives a plurality of the sub-addresses of the receiving Internet facsimile apparatuses in a single facsimile transmission. However, it is a matter of well known in the prior art that the user can send facsimile data to a plurality of receiving facsimile apparatuses. For instance, Yoshida teaches in claim 1 a reception means for "receiving at least a sub-address and transmission data" (col. 35, lines 23-24). That means the communication apparatus in Yoshida can receive more than one sub-address. It would have been obvious to one skilled in the art at the time the invention was made to consider the communication system in Fig.29 of Yoshida can receive more than one sub-address of the receiving Internet facsimile apparatuses since Yoshida also teaches the case the reception means of the system can receive more than one sub-addresses of the receiving Internet facsimile apparatuses.

Same discussion in claim 11 above is repeated for claim 16.

Claim 17 is method claim of apparatus claim 11 above. Claim 17 is rejected for the same rationales set forth for claim 11.

3. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida as applied to claim 1 above, and further in view of Mori (US Patent No. 6,384,927).

Concerning claim 14, Yoshida fails to teach that the controller transmits the sub-address using a NSS signal. From the same field of endeavor, Mori discloses an Internet facsimile

Art Unit: 2626

machine transmitting image data to a relay Internet facsimile apparatus (Figs. 1-2) which uses NSS signal to transmit the sub-address of the receiving Internet facsimile apparatus (col. 10, lines 53-57). It would have been obvious to one skilled in the art at the time the invention was made to combine the above teaching of Mori to the facsimile apparatus in Yoshida since Yoshida also teaches the group 3 facsimile communications using T30 wherein the use of NSS is a matter of well known in the prior art.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

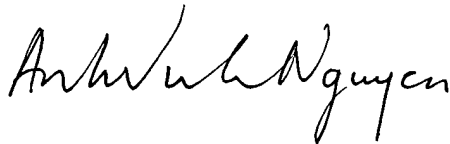
a. Idehara (US 2002/0032736) discloses a communication having multiple communication functions of selecting a communication route among multiple communication routes that are available between the sending equipment and receiving equipment.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-7466. The examiner can normally be reached on Monday, Tuesday, Thursday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on 571 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Anh W. Nguyen". The signature is fluid and cursive, with the first name "Anh" and last name "Nguyen" clearly legible.

Madeleine AV Nguyen
Primary Examiner
Art Unit 2626

March 17, 2006